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IN THE

# Supreme Court of the United States

OCTOBER TERM 1930.

No. 48.

AMERICAN FRUIT GROWERS, INC., *Petitioners,*

v.

BROGDEX COMPANY, *Respondent.*

## MOTION ON BEHALF OF THE STATES OF ALABAMA, ARIZONA, CALIFORNIA, FLORIDA, GEORGIA, LOUISIANA AND TEXAS FOR LEAVE TO FILE BRIEF AND TO BE ORALLY HEARD AS AMICI CURIAE AND BRIEF AS AMICI CURIAE.

CHARLIE C. MCCALL,
*Attorney-General, State of Alabama.*

K. BERRY PETERSON,
*Attorney-General, State of Arizona.*

U. S. WEBB,
*Attorney-General, State of California.*

FRED H. DAVIS,
*Attorney-General, State of Florida.*

GEORGE M. NAPIER,
*Attorney-General, State of Georgia.*

PERCY SAINT,
*Attorney-General, State of Louisiana.*

ROBERT LEE BOBBITT,
*Attorney-General, State of Texas.*

November 25, 1930.

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OCTOBER TERM 1930.

No. 48.

AMERICAN FRUIT GROWERS, INC., *Petitioners*,

v.

BROGDEX COMPANY, *Respondent*.

## MOTION FOR LEAVE TO FILE BRIEF AND TO BE ORALLY HEARD AS AMICI CURIAE.

*May it Please the Court:*

The undersigned, Attorney-Generals of the States of Alabama, Arizona, California, Florida, Georgia, Louisiana and Texas respectfully move this Honorable Court for leave to file the accompanying brief and to be orally heard in this cause as amici curiae.

If the Court grants this motion, the several counsel will agree amongst themselves in respect of which one of them will present oral argument on behalf of them all.

CHARLIE C. McCALL,
*Attorney-General, State of Alabama.*

K. BERRY PETERSON,
*Attorney-General, State of Arizona.*

U. S. WEBB,
*Attorney-General, State of California.*

FRED H. DAVIS,
*Attorney-General, State of Florida.*

GEORGE M. NAPIER,
*Attorney-General, State of Georgia.*

PERCY SAINT,
*Attorney-General, State of Louisiana.*

ROBERT LEE BOBBITT,
*Attorney-General, State of Texas.*

# Supreme Court of the United States

The decision of the Circuit Court of Appeals for the Third Circuit in this case is to be found in 35 Fed. (2) 106 (Transcript of Record, page 705) and that of the District Court in 21 Fed. (2) 110.

## STATEMENT OF FACTS.

On the 15th day of April, 1926, respondent instituted suit in the United States District Court for the district of Delaware for infringment of United States Letters Patent No. 1,529,461, issued March 10, 1925, to Ernest M. Brogden and Miles L. Trowbridge on an application filed August 15, 1923. The bill charged the petitioner with infringement of certain process claims and article claims.

The patent in suit is directed to a method of preserving fruit, and more particularly relates to the prevention of decay of such fruit by retarding the development of blue mold. Claim 3, which reads as follows, may be considered as typical of the process claims:

> In the preparation of fresh fruit for market, the process which comprises subjecting fruit to the action of an aqueous solution of borax, the fluidity, strength and temperature of the treating solution, and the duration of the treatment, being such that exposed rind or skin tissues of the fruit are effectively impregnated with borax and rendered resistant to blue mold decay, while at the same time the fruit is not scalded nor is its freshness or edibility otherwise substantially impaired.

The following may be taken as typical of the article claims:

26. Fresh citrus fruit of which the rind or skin carries borax in amount that is very small but sufficient to render the fruit resistant to blue mold decay.

The District Court rendered a decree holding the claims of the patent valid and that petitioner infringed claims 1 to 7, 9, 14 to 18, and 23 to 26 inclusive. This decision was affirmed on appeal by the Circuit Court of Appeals for the Third Circuit. Petitioner sought a rehearing, which was denied on November 15, 1929. A petition for the writ of certiorari was granted by this Honorable Court March 17, 1930.

## OUTLINE OF ARGUMENT.

I. Oranges as Defined in Claims 23 to 26 of the Brogden and Trowbridge Patent are not an Article of Manufacture under the Patent Statutes. (p. 6.)

II. The Process and the so-called Article of Manufacture Defined in the Claims of the Brogden and Trowbridge Patent do not Involve Invention over the Disclosure of the Bishop Patent, No. 683,899, issued in the year 1901. (p. 11.)

III. If the Brogden and Trowbridge Patent is held Valid, It will Constitute a Serious Abridgment of the Rights of the Fruit Growers of the United States. (p. 27.)

IV. Adoption of a Process by an Industry Should be Evidence of Invention only in a Doubtful Case. (p. 31.)

V. Conclusion. (p. 35.)

## ARGUMENT.

### I.

### Oranges as Defined in Claims 23 to 26 of the Brogden and Trowbridge Patent are not an Article of Manufacture under the Patent Statutes.

The lower courts have held herein that claims 23 to 26 of the Brogden patent are valid and infringed by oranges sold by the petitioner. Such oranges are to all appearances the same as oranges fresh from the trees and differ therefrom only by having a minute quantity of borax upon their rinds. The question presented for determination by this Honorable Court is whether such an orange is a "manufacture" within the meaning of that term as it is used in Section 4886 of the Revised Statutes (Section 31, Title 35 U. S. C. A.).

Counsel have been unable to find any case decided by this court wherein the precise meaning and limits of the term "manufacture", in the patent sense, is defined. The most nearly applicable decisions of this court upon this question, however, appear to be in direct conflict with the decisions herein by the District Court and the Circuit Court of Appeals, as will hereinafter be pointed out.

The holding of the lower courts to the effect that an orange treated in accordance with the process set forth in the patent is proper subject matter for patent protection is evidently based upon the definition of the term manufacture given in the case of *Riter-Conley Manufacturing Company v. Aiken et al.*, 203 Fed. 699. The Circuit Court of Appeals cited that case in support of its holding that the article claims were directed to patentable subject-matter. Now the

Riter-Conley case in turn adopted the definition given in *Johnson v. Johnston,* 60 Fed. 618, 620, to the effect that "the term 'manufacture' as used in the patent law, has a very comprehensive sense, embracing whatever is made by the art or industry of man, not being a machine, a composition of matter, or a design". While the actual holding of the Riter-Conley case, to the effect that a roof structure is a manufacture, is believed sound, it is submitted that the definition of "manufacture" given therein is far too inclusive.

For instance, there was involved in the case of *Armstrong Seatag Corporation v. Smith's Island Oyster Company,* 254 Fed. 821, a patent for an oyster having affixed to it an identifying tag. Such a tagged oyster did not occur in nature, was made by the hand of man, and was obviously not a machine, a composition of matter, nor a design. Yet the court had no difficulty in holding that it was not a manufacture, in the following language (See page 822):

> "If the patent in suit be supposed to cover a tagged oyster, the answer is that a tagged oyster is not a machine or a composition of matter, and it is not a manufacture. A spring chicken, with an identifying tag fastened to its leg, is closely analogous. If he so desired, any fisherman could attach an identifying tag to his fish. But none of these natural products could be classed as manufactured articles, simply because of being tagged."

It is believed the soundness of the above decision will not be questioned. A tagged oyster is still an oyster and the intellect revolts at calling it an article of manufacture.

By the same token, a tagged orange would not be an article of manufacture, although it does not occur in nature and fits into the definition given in the Riter-Conley case. And yet such an orange would appear to approach an article of manufacture much more than the oranges here under discussion which, to all appearances, are the same as they would be in their natural state.

Similarly, such an inclusive definition of the term "manufacture" is criticized as being too broad in the case of *Knight v. Reiger et al.*, 203 Fed. 49, affirmed by the Circuit Court of Appeals for the Fourth Circuit, 212 Fed. 935.

The Riter-Conley case rested its definition largely upon similar definitions given in cases dealing with other branches of the law. A review of the decisions in these other fields, however, reveals that in the cases which involved anything similar to a treated orange or a coated orange, such articles are held not to be manufactures. Thus, in the case of *Myers & Company v. The United States,* 147 Fed. 204, the Circuit Court of Appeals for the Second Circuit held that lumber which had been processed for fire-proofing, and its value largely increased thereby, was not dutiable as a manufacture from wood. Again in *Kreshower v. The United States,* 152 Fed. 485, the Circuit Court for the Southern District of New York held that leaves which had been subjected to a process including the application of glycerine and varnish to preserve them were not manufactures, stating on page 486:

> "The treatment did not result in a change of the leaves from their former appearance. There was no advance in maufacture in the sense that

the process of preservation destroyed the orginal articles or made them useful for other purposes or altered their trade designation. Hartranft v. Wiegmann, 121 U. S. 609."

Coming now to the pronouncements of this Honorable Court, we invite attention to the case of *Anheuser-Busch Brewing Association v. The United States,* 207 U. S. 556, where the question was whether corks which had undergone a treatment requiring several days were "manufactures" under the tariff law. Answering a contention similar to that urged by the respondent here, this Court on page 562 stated:

> "* * * Manufacture implies a change, but every change is not manufacture, and yet every change in an article is the result of treatment, labor and manipulation. But something more is necessary, as set forth and illustrated in Hartranft v. Wiegmann, 121 U. S. 609. There must be transformation; a new and different article must emerge, 'having a distinctive name, character or use'. This cannot be said of the corks in question. A cork put through the claimant's process is still a cork."

In the case of *Hartranft v. Wiegmann,* 121 U. S. 609, a similar question, involving shells (of mollusks) submitted to treatment, was before this court. It was stated (page 615):

> "They were still shells. They had not been manufactured into a new and different article, having a distinctive name, character or use from that of a shell. The application of labor to an article, either by hand or by mechanism, does not make the article necessarily a manufactured

> article, within the meaning of that term as used in the tariff laws. Washing and scouring wool does not make the resulting wool a manufacture of wool. Cleaning and ginning cotton does not make the resulting cotton a manufacture of cotton."

Thus, lumber treated by a fire-proofing process is still lumber and not a manufacture; leaves treated and coated with glycerine and varnish to preserve them are still leaves and not a manufacture; corks which had been subjected to a process extending over several days and involving treatment in a chemical bath are still corks and not manufactures; and mollusk shells treated with acid, polished, etc., were still shells and not manufactures—how then can an orange containing a miscroscopic quantity of borax on its skin be considered a manufacture? While these decisions do not involve patent law, it is submitted that the above expressions of this court relative to the term "manufacture" are directly applicable in a patent case where that term is to be defined. And as a matter of fact, such non-patent cases formed the basis of the decision in the Rifer-Conley case. The logic used in such cases is equally true when transferred to another branch of the law.

To hold contrary to the doctrines of the above cases would be to admit a host of new articles for patent protection; other types of fruit treated with borax; citrus fruit treated with other reagents; lumber treated for fire-proofing; leaves treated with glycerine or varnish for preservation; corks submitted to a certain chemical bath; in fact, any of the numberless natural products treated by any of innumerable similar processes. Indeed, if such a definition were

adopted, could an orange coated with borax while it is still on the tree be logically excluded? Certainly to include such treated natural products in the class of patentable inventions seems to go far beyond the intent of the statute.

It is accordingly submitted that an orange, coated with a minute quantity of borax, is still a natural product and not a "manufacture" as that term is used in patent law, and that the ruling of the Court of Appeals to the effect that the complete article is not found in nature, and is thus an article of manufacture is erroneous.

## II.

**The Process and the so-called Article of Manufacture Defined in the Claims of the Brogden and Trowbridge Patent do not Involve Invention over the Disclosure of the Bishop Patent, No. 683,899, issued in the year 1901.**

It is appropriate to here inquire just what was the knowledge of the public at the time of the alleged invention by Brogden and Trowbridge. Or more specifically, with what knowledge was the public charged at that time? In view of that knowledge was any inventive genius required to adopt the process of the Brogden and Trowbridge patent?

The record is replete with evidence showing that the public was thoroughly informed of the antiseptic and disease-inhibitive properties of borax, boracic acid and in general compounds containing the boric acid radical. As a matter of fact, its value as a specific for blue mold decay was well recognized by the art. It is believed, however, that the time of this

court may be saved by confining the consideration of the prior art to a single patent.

Years prior to the adoption of the Brogden and Trowbridge process, a process substantially the same had been developed and patented by one Simeon Bishop. The Bishop patent, No. 683,899, which issued on October 8, 1901, will be found on pages 1473 and 1474 of the Transcript of Record, and the detailed comparison of it with the Brogden and Trowbridge patent hereinafter presented shows how completely it discloses the substance of the later so-called invention.

At this point one phase of this matter calls for passing reference. It will be pointed out herein that the processes of both the Bishop and the Brogden and Trowbridge patents consist in general of two identical steps; first, treatment of the oranges in a solution of a boric acid radical compound, and second, the application to the orange so treated of a wax or gelatin coating. The processes of these two steps are identical in the two patents, and the final product necessarily is the same in each case. The claims which were held to be infringed are directed merely to the first step, namely, treatment of the orange in the solution of boric acid or borax. Omitting the second step of the Bishop process will give exactly the same result as omitting the second step of the Brogden and Trowbridge process. In this connection the attention of the Court is directed to the well settled doctrine that the omission of an element in a combination with its corresponding function does not render the elements retained patentable. As was said in the case of *Richards v. Chase Elevator Company*, 159 U. S. 477, 486:

> "While the omission of an element in a combination may constitute invention, if the result of the new combination be the same as before; yet if the omission of an element is attended by a corresponding omission of the function performed by that element, there is no invention, if the elements retained perform the same function as before."

See also *Giles et al. v. Heysinger*, 150 U. S. 627; *McClain v. Ortmayer*, 141 U. S. 419.

Bishop states that his process is to be used on "fruit, vegetables, eggs, and the like" (Transcript of Record, page 1473, line 3 from bottom). While much has been said as to the specific use of their process on oranges to control blue mold decay, Brogden and Trowbridge, in their patent specification, state that this is merely the "greatest present utility" of the process, and continue (Transcript of Record, page 586, bottom):

> "* * * The invention is broad, however, and the term fruit as herein employed is to be understood as not necessarily restricted to fruit in the sense in which the word is usually employed, but is to be understood broadly as including not only fruit proper but also vegetables, such as tomatoes or the like, that can be treated to advantage in accordance with the principles of the invention to be hereinafter set forth."

It is to be noted that blue mold decay is not peculiar to citrus fruits. Brogden and Trowbridge, by their own admissions, concede its attack on other food products. Furthermore, it is to be remembered that blue mold is one of the most common forms of fruit decay.

As stated by the Broughton and Trowbridge specification, "In general, the purpose of the invention is to provide a reagent comprising the boric acid radical" (Transcript of Record, page 569, middle). Bishop describes the use of "borated acid" (Transcript, page 144, lines 7, 16 and 21), which is merely another name for boric acid (*Webster's New International Dictionary, 1929*). Obviously, borax or borazic acid is a reagent comprising the boric acid radical. In fact, borax acid is specifically mentioned as a possible reagent in the Broughton and Trowbridge specification (Transcript, page 569, line 23). Broughton and Trowbridge thus have merely broadened the term boric acid into a "reagent comprising the boric acid radical". Since boric acid is a very weak acid, however, it is apparent that its antiseptic properties are not due to the hydrogen ions present in it, but to the boric acid radical, and such broadening is therefore an obvious step. Moreover, the other reagents containing this radical, particularly borax, are well known antiseptics. This knowledge, indeed, has become crystallized in the English language, for the term "borated" has long been used to mean "mixed or impregnated with borax or boric acid" (*Webster's New International Dictionary, 1909-1929*). Such changes involve merely the substitution of an equivalent for the boric acid used by Bishop.

It is of course well recognized that the substitution in a compound of a substance recognized as the equivalent of a substance formerly used in the compound, does not involve invention.

In *Hopkins Mfg. Co. v. General Electric Co.*, 212 Fed. 422, it was said at page 429:

> * * * I think that two compositions of matter in which the same constituent elements predominate are equivalents, when the function or essential properties of each entire composition are substantially the same. Robinson on Patents, Sec. 304; Walker on Patents (4th Ed.) Sec. 369; Tyler v. Boston, 7 Wall. 327, 19 L. Ed. 93."

Again in *National Enameling and Stamping Co. v. New England Enameling Co.*, 153 Fed. 184, the court stated (page 186):

> "If a metallic salt of any kind was previously used, the substitution of another metallic salt which produced the same result would be the employment merely of an equivalent."

The case of *Western Willite Co. v. Trinidad Asphalt Mfg. Co.*, 16 F. (2) 446 contains the following similar language (See page 450):

> "It is true, as the trial judge recognized, that 'ordinarily, the reactions and phenomena of chemistry may sometimes dictate a rule as to equivalents, which is at variance to that rule as applied to mere physical or mechanical equivalents.' But, as he said, we are 'unable to see any reason for applying a different rule in a case wherein the effect produced by one metallic sulphate is in all respects similar to those produced by other metallic sulphates,' especially when operating in combination upon substances possessing well-known characteristics. It is only when the reactions and phenomena of chemistry are latent and undeveloped that the rule invoked by appellants has application."

Under the principle enunciated in the above cases, it is submitted that reagents containing the boric acid radical are equivalents of the boric acid used in Bishop's process and that their use involves no invention over such prior process. The equivalency of boric acid and borax was well recognized by the art prior to the Brogden and Trowbridge patent, as is illustrated by the patent to Storer (Transcript of Record, page 1599, lines 23 to 26).

Brogden and Trowbridge state that the reagent is applied as follows (Transcript of Record, page 589, last five lines, page 590, first twelve lines):

> "The method of applying the treating solution to the fruit may assume various specifically different forms, the precise details of procedure being not essential to the invention in its broader aspects. However, where it is desirable, as may often be the case, to carry out the process without changing prior practice any more than is strictly necessary, the application of the mold-retarding agent may be effected as a part of or in conjunction with the usual washing operation to which the fruit is initially subjected in its handling according to modern packing house methods, especially as most of the mold-retarding agents herein contemplated also have excellent cleansing or detergent properties. Accordingly, in the practice of the invention, the mold-retarding agent, borax in a specific instance, may be added in proper mold-inhibiting quantity directly to the wash water in the usual soaking tank into which the fruit is dumped from the field boxes as it comes from the groves."

In the Bishop patent, the reagent is applied in "an antiseptic bath", wherein the article of food is "washed or bathed" (Transcript of Record, page

1474, lines 2 and 6). Bishop uses two ounces of boracic acid to one gallon of water (Transcript of Record, page 1474, lines 21 to 23). Such proportions will give a one and a half per cent solution. Brogden and Trowbridge, after stating that "the strength or concentration of the treating solution may be varied considerably within reasonable limits", give examples of solution ranging from two to twenty per cent, and state that "a solution containing two per cent or more of borax may be characterized as a strong solution" (Transcript of Record, page 590, bottom; page 591, top). Here again, if there be any change, it is merely an obvious carrying forward of the principles of Bishop's invention.

Bishop states that the application of boracic acid in his process "is advantageous in that it prevents decay" (Transcript of Record, page 1474, lines 16 and 17). Brogden and Trowbridge state (Transcript of Record, page 586, middle):

> "This invention relates to art of preparing fresh fruit for market; and in particular it relates to processes for the treatment of citrus and other fruits in such manner that the development of molds and the like upon the fruit, and especially the development of blue mold and infection by blue mold spores, is prevented or arrested either wholly or to such large extent as greatly to prolong the marketable life of the fruit beyond what has been possible heretofore * * *"

Thus, despite the fact that Bishop, writing some twenty-three years earlier, did not use such scientific terms as the later patentees, the purpose and intent of both is obviously the same—and the results identical.

Brogden and Trowbridge continue as follows (Transcript of Record, page 592, middle):

> "* * * It is permissible within the scope of the invention, to rinse the fruit with clean water containing no treating reagent after it leaves the washing machine and before it enters the drier. * * *."
>
> * * * * * * * *
>
> "* * * The fruit, after passing through the drier, carries a substantial deposit of the solid treating reagent, borax in the specific example here in question. The stronger the treating solution employed, the greater is of course the amount of this surface deposit of white pulverulent material on the fruit. If this were allowed to remain on the fruit, the fruit might be unmarketable because of its appearance, and hence the fruit may be next treated to remove this superficial deposit. This can be accomplished most effectively by a dry brushing or rubbing of the fruit, most desirably by means of rotary cylindrical brushes of horsehair or the like operating at relatively high speed. * * *"

Such rinsing and brushing, to be carried out when a strong solution is used, obviously reduces the amount of reagent left on the fruit. Thus, though Brogden and Trowbridge may use a stronger solution of reagent, the net amount of reagent left upon the fruit as a protective film would be substantially the same as that obtained by using Bishop's process. Finally, they state (Transcript of Record, page 593, middle):

> "From this point on, the handling of the fruit in further preparation for boxing and shipment may or may not involve additional preservative

treatment in accordance with the principles of the invention. This depends upon whether or not the fruit is to receive an application of protective coating material for the purpose of preventing or reducing shrinkage and withering and of ensuring conservation of the original freshness and flavor of the fruit for prolonged periods of time. Generally this further treatment is highly desirable, and if the benefits of the invention are to be realized to the fullest extent, this further treatment should be carried out. It consists in applying to the fruit a normally solid protective material, especially paraffin or like waxy material, in such condition that it can be spread all over the surface of the fruit to produce an extremely thin protective film which is not noticeable except by the expert eye and does not interfere with the so-called breathing or transpiration of the fruit to an undesirable extent, but which is effective to conserve the original plumpness and freshness of the fruit as above stated."

Bishop similarly states (Transcript of Record, page 1474, lines 9 to 11):

"* * * The article is then coated with gelatin, which excludes the air and prevents the entrance of atmospheric germs, thereby preventing decay."

The anticipatory character of the Bishop patent is perhaps more clearly apparent from the following summary of the foregoing discussion.

| | BISHOP | BROGDEN AND TROWBRIDGE |
|---|---|---|
| **Material treated** | Fruits, vegetables, eggs and the like (Rec., p. 1473) | Fruits and Vegetables—greatest utility citrus fruits (Rec., p. 586) |
| **First ingredient used** | Boracic (Boric) acid (Rec., p. 1474) | Reagent comprising the boric acid radical (boric acid or borax) (Rec., p. 589) |
| **Amount used** | 2 oz. to gallon—1¼% (Rec., p. 1474) | 2 to 20%—when strong solution used oranges may be rinsed with clean water, or brushed off when dry (Rec., pp. 591, 592) |
| **Purpose** | To prevent decay (Rec., p. 1474) | To prevent blue mold and all kindred rot and decay organisms and diseases to which fruit is susceptible (Rec., p. 597) |
| **Second ingredient used** | Gelatin (Rec., p. 1474) | Paraffin or like waxy material (Rec., p. 593) |
| **Purpose** | To exclude air, prevent entrance of germs, add to appearance (Rec., p. 1474) | To form protective film and to prevent withering, shrinkage, etc. (Rec., p. 593) |
| **Results** | An orange coated with boracic acid (a reagent containing the boric acid radical) to prevent decay, and with a protective coating of gelatin to exclude germs and add to appearance. | An orange coated with a reagent containing the boric acid radical to prevent decay, and with a protective coating of paraffin or like waxy material to form protective film and conserve the orange. |

Thus every essential step individually and in combination, of the Brogden and Trowbridge process is paralleled in the process of Bishop, and if not in fact anticipated, the changes made are at least well within the knowledge of those skilled in the art and rendered invalid the Brogden and Trowbridge process. Bishop, speaking with the practical knowledge of the art as of the year 1900, and writing his specification with the conciseness typical of the applications for patent of that time, nevertheless has described his process in full, clear, concise and exact terms. Not only did Bishop clearly disclose the steps of his process and the result achieved thereby, but he informed the public of the functions of his ingredients—functions identical with the functions subserved by Brogden's and Trowbridge's similar, or at least equivalent, ingredients.

The Brogden and Trowbridge application was written with the background of scientific knowledge as of a date some twenty-three years later, and under the present practice of giving a very full description in the specification; but such verbosity can not supply an absence of invention where it is in reality lacking. The later process, when reduced to its essentials, is practically and substantially that described by Bishop.

That both Bishop and Brogden and Trowbridge were seeking the same result by the same means is further evidenced by a comparison of certain claims of the two patents. Bishop's first claim (Transcript of Record, page 1474, bottom) reads as follows:

> 1. The method of treating articles of food to preserve and enhance their value, which consists in washing them with a solution of boracic acid and then applying a coating of gelatin, substantially as described.

Now note the following claim made by Brogden and Trowbridge (Transcript of Record, page 601):

> 19. In the preparation of fresh fruit for market, the process which comprises contacting the entire surface of fresh fruit with a solution containing borax in sufficient concentration to exert pronounced mold-inhibiting action, and thereafter applying to the fruit so treated a thin, film-like protective coating comprising waxy material.

The following article claims made by the later patentees are also submitted for consideration (Transcript of Record, pages 602, 603):

> 25. Fresh citrus fruit of which the rind or skin carries a non-poisonous mold-inhibiting compound comprising the boric acid radical, the amount of said compound present being very small but sufficient to render the fruit resistant to blue mold decay.
>
> * * * * * * * *
>
> 27. Fresh citrus fruit as defined in claim 25, further characterized by the fact that its surface is provided with a thin film-like protective coating of waxy material.

The mere comparison of such claims emphasizes the identity of the two processes. The fact that the Bishop patent contained no article claims is immaterial, since the product claimed by Brogden and Trowbridge in 1925 inevitably resulted from the practice disclosed by Bishop in 1901. It is an elementary principle of patent law that an article patent cannot be secured where such article necessarily resulted from a process described in an earlier patent.

It is not believed necessary to consider at length

all of the remaining claims in suit. Practically the only difference specified therein which has not already been discussed is the mild heating to about 115° to 120° F. of the treating solution. Such heating has merely the well-known effects of aiding the dissolution of the reagent and increasing its activity, and does not cause any critical or essential change in the process. All of the claims, it is submitted, are unpatentable over the disclosure of the Bishop patent.

Much stress has been laid upon the utility of the process when applied to oranges. As has been pointed out previously, however, Brogden and Trowbridge state that that is merely the greatest present utility of the process, and that the process may be used on vegetables. Moreover, the Bishop patent contemplated its application to oranges, and, as a matter of fact, the process was actually used on oranges (Transcript of Record, pages 177 to 183). But even assuming that Bishop did not practice his process on oranges, and the case against the Brogden and Trowbridge patent must rest on Bishop's statement that his process was to be used on the broad class of "fruit", there would be no invention by Brogden and Trowbridge in applying Bishop's process specifically to oranges to accomplish the same result. As was stated in *Milligan and Higgins Glue Company v. Upton*, 97 U. S. 3, 6:

> "Where certain properties are known to belong generally to classes of articles there can be no invention in putting a new species of the class in a condition for the development of its properties similar to that in which other species of the same class have been placed for similar development."

The earliest authoritative case upon this subject, however, is the famous case of *Brown v. Piper,* 91 U. S. 37, in which this Honorable Court held that the process of preserving fish by refrigeration was unpatentable in view of a prior similar process for preserving corpses. After referring to the prior process this Court stated (page 41):

> "Here was the application of the requisite degree of cold, exactly in the manner called for in the specification of the appellee.
>
> "This is hardly denied; but it is insisted that the process was never applied by the witness to the preservation of fish and meats.
>
> "The answer is that this was simply the application by the patentee of an old process to a new subject, without any exercise of the inventive faculty and without the development of any idea which can be deemed new or original in the sense of the patent law. The thing was within the circle of what was well known before, and belonged to the public. No one could lawfully appropriate it to himself and exclude others from using it in any usual way for any purpose to which it may be desired to apply it.
>
> "This is fatal to the patent. Ames v. Howard, 1 Sumn. 487; Howe v. Abbott, 2 Story, 194; Bean v. Smallwood, 2 Story, 411; Winans v. R. Co., 2 Story, 412; Hotchkiss v. Greenwood, 11 How. 248."

In the above case, the holding is to the effect that the arts of preserving fish and preserving corpses are analogous, and the carrying over of a process from one to the other does not involve invention. In the present case, Brogden and Trowbridge have done little more than to attempt to restrict the process, used before on "fruit" (including "oranges"), to a

specific kind of fruit, namely, citrus fruits of which oranges are one variety.

The principles of *Brown v. Piper, supra*; still represent the view of this court. We here invite particular attention to the case of *Berlin Mills Company v. Procter & Gamble Company*, 254 U. S. 156, where this court, after an examination of the prior art, with the knowledge of which the patentee was conclusively charged, held invalid a patent relating to a lard-like food product consisting of a vegetable oil partially hydrogenized, on the ground that the process in suit merely broadened such prior art to a new class of products, and that this did not constitute invention. On pages 165-6 the court say:

> This record establishes that it was known before Burchenal took up the subject that a vegetable oil could be changed into a semi-solid, homogeneous, substance by a process of hydrogenation arrested before completion and that it might be edible. This much of the art was public property and open to general use. The product of this process was known and open to public use. To supply such products as the patentee has described in the broad claims in suit may have been new and useful, but does not in our opinion arise to the dignity of invention, and is an advance step which would occur to one skilled in the art when investigating and considering the subject.

This language is directly applicable to the facts in the instant case; for Brogden and Trowbridge were conclusively presumed to have known of the prior art, including the Bishop patent, and their application of the Bishop process to citrus fruits would not amount to invention over such prior art. Further-

more, by the time of the Brogden and Trowbridge application, the Bishop process and the product thereof were "public property and open to general use."*

That the Circuit Court of Appeals in deciding the instant case, departed from these well-known and controlling principles, is disclosed by the following from its opinion (Transcript of Record, p. 577).

> "* * * We have an old and well-known substance applied in a new and useful way, and this constitutes invention."

Had the court below given sufficient weight to the Bishop patent, counsel are convinced the court could not have concluded Brogden and Trowbridge had developed "a new and useful" application of boric acid. However, even conceding, for the purpose of argument, that there was a "new and useful way" of application, mere novelty and utility alone can not constitute invention. The "new and useful way" must have been unobvious. To repeat (italics ours):

> "To supply such products as the patentee has described in the broad claims in suit *may have been new and useful, but does not in our opinion arise to the dignity of invention*, and is an advance step which would occur to one skilled in the art when investigating and considering the subject." (*Berlin Mills Co. v. Procter & Gamble Co., supra*, p. 166.)

To the same effect are *McClain v. Ortmayer et al.*, 141 U. S. 419 (See page 32 hereof); *Electric Boot and Shoe Finishing Company v. Little*, 138 Fed. 732, and *Baker v. Duncombe Manufacturing Company*, 146 Fed. 744.

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*Indeed, as shown by the matters contained in the Appendix, p. 37, the experiments of Brogden and Trowbridge followed exactly upon the lines of others made in the Department of Agriculture nearly twenty years before, and we contend the results obtained would have been secured by anyone "skilled in the art when investigating and considering the subject", p. 25. These experiments of the Department of Agriculture in 1905 and of Brogden and Trowbridge in 1923 were both within the disclosures or obvious applications of the Bishop patent of the year 1901.

It is submitted that the holding of the Circuit Court of Appeals is contrary to the law of the other circuits and the law laid down by this Honorable Court, as evidenced by the cases cited.

## III.

### If the Brogden and Trowbridge Patent is held Valid, It will Constitute a Serious Abridgment of the Rights of the Fruit Growers of the United States.

It is a fundamental principle of patent law that, in consideration of the seventeen year monopoly granted to the inventor, the public shall be free to enjoy the invention after the monopoly has expired. Or, to state the matter more specifically, after Bishop had enjoyed his seventeen year monopoly, the fruit growers of the United States were free to use his process. In such use of the Bishop process, moreover, the fruit growers would not be confined to the precise process disclosed by Bishop, but could modify that process in the light of the knowledge common to those skilled in the art as amply shown by authorities hereinafter cited under this point.

Previously in this brief, it has been pointed out that the essential steps of the Brogden and Trowbridge process are anticipated by Bishop's process, and that any changes made by the later patentees are non-inventive variations and expansions of Bishop's invention. To grant a second monopoly to Brogden and Trowbridge would, therefore, be a serious abridgment of the rights of the American public, and more specifically, the fruit growers of the United States, who, under the fundamentals of patent law, should be free to use the invention after the first monopoly

had expired. Validation of the Brogden and Trowbridge patent would be to place in the hands of these later patentees the power to exact an unjust tribute, over an additional period of seventeen years, from an important and basic industry of this country; a tribute that would be onerous alike to the extensive citrus fruit industry and to the American public which consumes the products of that industry in ever increasing amounts.

The present situation is not unlike that in the case of *Minerals Separation North American Corporation v. Magma Copper Co.*, recently decided by this court and reported at 280 U. S. 400. In that case, the petitioners owned two patents concerning mineral separation, and the validity of the later patent over the former one was in issue. On page 402 this court stated:

> "The petitioners, admitting that both patents are for processes, says that they are fundamentally different in their respective principles of action; that in the present patent, 962,678, the mineral frothing agent is dissolved in the water and produces the metal-bearing bubbles, no one knows exactly how, by 'modifying the water'; whereas in the earlier, 835,120, oil is used which does not dissolve in the water but coats the particles of metal with a thin coating of oil, which it could not do if it were soluble, and thus shows its preferential affinity when shaken up with the metal pulp.
>
> "The question is not what is the precise scope of the claims in 835,120, but what is disclosed in the specification and made known to the world. Alexander Milburn Co. v. Davis-Bournonville Co., 270 U. S. 390."
>
> * * * * * * * * *

Again, page 403:

> "But we agree with the defendant's argument that no one concerned in this business would care a straw as to the intimate nature of the action if it produced the result, and that No. 835,120 was not describing the work of insolubles alone. It was not attempting to anticipate a theory of the invisible, but to tell how the practical end could be achieved with any of the different things named."

* * * * * * * * *

Further, on page 404:

> "The patent having been held good as to the oils, although experiment was necessary to find out what oil would work best with a given ore, the disclosure was an anticipation, although experiment might be necessary to choose among the substances having the required affinity the one that would produce the best result."

It is respectfully submitted that the present case is much clearer, for in it there is none of the uncertainty as to the substituted reagents producing similar results, and no requirement for further experimentation to determine such a question. The efficacy of borax and other borates has long been well known to have preserving qualities similar to that of boric acid. (See, for instance, Storer British patent No. 214 of 1888; Transcript of Record, p. 1599, lines 23 to 26.) It follows, *a fortiori*, that the second monopoly should be denied in the present instance.

In the foregoing section, only the Bishop patent has been considered as showing the use of reagents containing the boric acid radical as preservatives.

As a matter of fact, the record abounds with other patents and publications showing the use of such reagents. The United States Patent to Gahn, 161,944 (Transcript of Record, p. 1546) discloses the use of a powder compounded of boracic acid and other substances, which is to be applied to fruit and other vegetable products by rubbing and sprinkling over such articles. Indeed, Gahn states that a solution may be made from the powder, using as much as the water will dissolve, and the articles to be preserved dipped therein.

Again, in the British patent to Storer, No. 214 of 1888 (Transcript of Record, page 1598) there is disclosed a method of shipping and storing fruit which consists in packing such fruit in sawdust impregnated with a solution of boracic acid or borax. Oranges, lemons, and limes are specifically mentioned by Storer as subject to his treatment.

The Bitting article and the Boesekin and Waterman article (Transcript of Record, pp. 1507 to 1521) describe the effect of reagents containing the boric acid radical in more scientific terms. For the sake of brevity, these and other publications and patents showing the use of such reagents have not been dealt with specifically, since it is believed that the Bishop patent in itself is sufficient to show that the Brogden and Trowbridge process is unpatentable. If, for any reason, it should be thought that a further showing is required, the supplemental art referred to above is believed to be more than sufficient.

It may be added that it is not desired to insinuate that there was any bad faith on the part of Brogden and Trowbridge. These later patentees followed along the footsteps of Bishop, apparently unaware

that he had preceded them. As a matter of fact, the Bishop patent also escaped the Patent Office in the prosecution of the Brogden and Trowbridge application. But such matters cannot affect the result. Brogden and Trowbridge and the public, of course, are charged with knowledge of all prior patents and publications. Long prior to the later patentees, Bishop had discovered the invention and fully described it in his patent. On the expiration of that patent, the field of invention covered thereby became definitely public property. The second grant of the same subject matter is therefore void. Or, to view the matter as a contractual one rather than as a question of property, the Brogden and Trowbridge patent fails for a lack of consideration. They had no new invention to offer in return for their grant, for their "invention" had long before been disclosed to the public by Bishop.

## IV.

### Adoption of a Process by an Industry Should be Evidence of Invention only in a Doubtful Case.

The Circuit Court of Appeals for the Third Circuit made the following holding in the present case (Transcript of Record, p. 577):

> "This new treatment of citrus fruit was adopted by the industry after elaborate tests by experts and citrus fruit organizations, which is strong evidence of invention. Westinghouse Air-Brake Co. v. New York Air-Brake Co., 59 Fed. 581, 593."

The decision of the Circuit Court of Appeals was apparently grounded to a substantial extent on this

statement, but it is respectfully submitted that, under the doctrine long recognized by this court and the courts of the several circuits, adoption of a process by the industry has no bearing upon a case such as the instant one. As amply shown under the preceding point, the Bishop patent substantially and fully anticipated the Brogden and Trowbridge process. Such modifications or amplifications as Brogden and Trowbridge may have made to the Bishop process were those which would suggest themselves to any person skilled in the art. There can be no doubt that such modifications required no inventive genius, but merely mechanical skill. The possibility, or perhaps even the desirability, of these changes would be apparent to anyone acquainted with the industry and prior art.

The courts have repeatedly cautioned against the dangers of over-emphasizing commercial adoption in determining the validity of a patent. For instance, in the case of *McClain v. Ortmayer et al.*, 141 U. S. 419, this Court stated (pages 427, 428):

> "Counsel for the plaintiff in the case under consideration has argued most earnestly that the only practical test of invention is the effect of the device upon the useful arts—in other words, that utility is the sole test of invention, and, inferentially at least, that the utility of a device is conclusively proven by the extent to which it has gone into general use.
>
> . . . . . .
>
> That the extent to which a patented device has gone into use is an unsafe criterion even of its actual utility, is evident from the fact that the general introduction of manufactured articles is as often effected by extensive and judicious

> advertising, activity in putting the goods upon the market, and large commissions to dealers, as by the intrinsic merit of the articles themselves. The popularity of a proprietary medicine, for instance, would be an unsafe criterion of its real value, since it is a notorious fact that the extent to which such preparations are sold is very largely dependent upon the liberality with which they are advertised, and the attractive manner in which they are put up and exposed to the eye of the purchaser."

Commercial adoption can only be considered where there is doubt. Where, as in the instant case, the patented process clearly did not involve the exercise of inventive genius, no amount of commercial exploitation can validate an otherwise invalid patent. Adoption by the trade can never be used to both create a doubt and resolve it. See *Lord and Burnham Company v. Payne*, 190 Fed. 172, in which it was said (p. 179):

> "This boundary, of course, is hard of demarcation, and, because it is so, novelty and utility are influential factors in determining invention, when the mind, seeking a pronouncement by applying the ordinary tests, is in doubt. The resort to novelty and utility, however, is not to be made to create a doubt. Such qualities cannot serve as both creator and solver of doubt. It is only when the mind is in doubt upon the consideration of the evidence affecting the question of invention as against mechanical suggestion, without regard to the thing being new and useful, that such latter qualities are available to throw the balance in favor of invention."

To the same effect, *Duer v. Corbin Cabinet Lock Company*, 149 U. S. 216; and *Slip Scarf Company v.*

*Filene's Sons Co.*, 289 Fed. 641, and cases therein cited.

It is submitted that the Circuit Court of Appeals for the Third Circuit in the instant case did not apply the law as laid down in the above cases, since it made its holding quoted at the beginning of this point before considering the anticipating effect of the Bishop patent, which was subsequently brushed aside with the other prior art with the comment "There was doubtless prior use of borax as a preservative". In other words, the adoption by the industry was used to create, as well as to resolve, a doubt.

As a matter of fact, the delay in the adoption of the process may be explained by many other factors. The Department of Agriculture was loath to recommend chemical treatment in view of the public opinion of those days—fostered by the pure food crusade of the late Dr. Harvey W. Wiley—upon the matter of chemical preservatives of food. Moreover, the Department and citrus associations were committed to the program of "careful handling" of the fruit, and they refrained from advocating the use of chemical preservatives (boric acid and borax particularly) for fear that if the growers were advised to employ such preservatives there would be a corresponding decrease in the care exercised in the handling of the fruit. And again, it is to be remembered that much of the present commercial success of the process is due to the efforts of the active corporation exploiting it. To use the wide adoption of the process, dependent upon such factors, to becloud the issues of novelty and invention, is improper. Such adoption by the industry should be considered only to resolve a doubt, and not to create it.

It is further submitted, as previously pointed out in this brief, that the Brogden and Trowbridge process involves no invention over the Bishop patent, and that there is thus no doubt to resolve. Or, to view the matter from another angle, whatever evidence of inventive subject-matter may be gathered from the adoption of the process by the trade, the invention is that of Bishop, and not of Brogden and Trowbridge, through whose greater energy and financial resources the process was exploited before the public. As pointed out in McClain v. Ortmayer, *supra*, it is not invention to bring to light the invention of another.

## V.

## Conclusion.

It is submitted that the holdings of the Circuit Court of Appeals for the Third Circuit to the effect that an orange coated with an invisible and minute quantity of preservative was an article of manufacfacture, within the meaning of the patent statute; that the application of an old process of preserving fruits and articles of food to a specific class of fruits constituted invention, and that adoption of a process by the industry is evidence of invention without considering whether or not the question of invention was doubtful, are contrary to the principles of law as established in other circuits and by this Honorable Court.

It is accordingly submitted that the judgment rendered by the Circuit Court of Appeals for the Third Circuit in the present suit should be reversed and

that the claims of the Brogden and Trowbridge patent in suit should be held invalid.

Respectfully submitted,

CHARLIE C. MCCALL,
*Attorney-General, State of Alabama.*

K. BERRY PETERSON,
*Attorney-General, State of Arizona.*

U. S. WEBB,
*Attorney-General, State of California.*

FRED H. DAVIS,
*Attorney-General, State of Florida.*

GEORGE M. NAPIER,
*Attorney-General, State of Georgia.*

PERCY SAINT,
*Attorney-General, State of Louisiana.*

ROBERT LEE BOBBITT,
*Attorney-General, State of Texas.*

November 25, 1930.

## APPENDIX.

When this motion and brief were in page proof form there was delivered to counsel copy of a letter dated November 6, 1930, from the Acting Secretary of Agriculture, Honorable R. W. Dunlap, and addressed to Honorable Doyle E. Carlton, Governor of the State of Florida.

As shown by this letter, a copy of which is printed below, the certificate of the Secretary of Agriculture dated January 18, 1927, being Defendants Exhibit No. 9 (Transcript of Record, 1475-80), furnished to the petitioners for use before the District Court, failed to have incorporated therein certain highly important material official records of his Department, due to failure to locate these records in the files of the Department at the time of such certification. These records conclusively show that the Department of Agriculture, by a series of experiments conducted in the year 1905 established, as the Acting Secretary states, that "the development of blue mold on citrus fruits was inhibited by dipping such fruits for a few minutes in a sufficient solution of boric acid and further that any surplus of boric acid crystals could be removed from the fruit by rinsing in fresh water without impairing the efficacy of the treatment." These records fully corroborate the statements made on page 34 hereof, to the effect that the failure of the Department to make these definitely favorable results known to the trade was due (a) to the belief that public fear of chemically treated fruit might result in the boycotting of American oranges, (Letter February 6, 1905, pp. 39-40, and Letter February 15, 1905, p. 40), and (b) to the assumption that the utilization of this process would lead to less careful handling of the fruit. (Letter November 8, 1909, pp. 43-44.)

The text of the Acting Secretary's letter follows (italics ours):

I have the honor to refer further to your telegrams of October 21 and 28, 1930, requesting certified copies of Departmental records dealing with experiments involving the application of boric acid to citrus fruits, conducted by the Bureau of Plant Industry, copies of which records were not contained under the Department's previous certificate dated January 18, 1927, obtained by the parties in interest for use in the case of American Fruit Growers, Inc., v. Brogdex Company, now pending in the Supreme Court of the United States.

In compliance with your request, I am enclosing the following described copies of newly discovered reports relating to the subject matter above described as follows:

| *Date* | *Nature of Record* |
|---|---|
| 1904 | |
| Dec. 31 | Letter from H. C. Gore to G. Harold Powell endorsed "four enclosures" but here accompanied by only two pages of notes now available, being a part of the notes shown in said Defendant's "Exhibit No. 9". |
| 1905 | |
| Jan. 5 | Letter from H. C. Gore to G. Harold Powell with five pages of notes and a sixth page showing a photograph of oranges with notations reporting on continued like boric acid work and discussion of same between Messrs. Taylor, Fulton, Scott and Gore. It is to be considered that these notes which are dated January 3, 1905 seem to fill a gap between the first two pages and the last four pages of such certified record (Defendant's "Exhibit No. 9"), and that there |

was an indication of an omission of said certified record from the fact that the first two pages are numbered 9 and 10 and the remaining pages numbered 16, 17, 18, 19.

*Date* *Nature of Record*

Jan. 5. Letter from William A. Taylor, Pomologist in Charge of Field investigations, to G. Harold Powell referring to the boric acid work, its "very striking results in the line of preventing rot development" and the conference thereon, as last above referred to.

Jan. 10 Letter from H. C. Gore to G. Harold Powell reporting further on said borax treatment and enclosing four pages of notes which form the conclusion of said certified record (Defendant's "Exhibit No. 9", pages 1477-1480); also a fifth page showing photograph of oranges with notations.

Jan. 11 Letter from G. Harold Powell to W. A. Taylor answering letter of January 5th, discussing treatment and commenting "People shy at the word borax now a days and I have not thought of suggesting it until the boys work a good deal more on it. Then we may try it on the quiet on a commercial scale."

*Date* *Nature of Record*

Jan. 13 Letter from G. Harold Powell to H. C. Gore replying to reports on boric acid treatment referred to as "striking", discussing same and referring to danger of draw-back from a commercial standpoint. "The trade shies at its own shadow and a borax panic could easily be worked up by the dealers in

foreign lemons who are fierce competitors with the Californians." Experiments suggested to determine minimum efficient strength of acid and minimum duration of dip, with reference to possibility of reducing the strength to the point where no crystallization on the fruit would be shown.

Jan. 17 Concluding date of report on work in continuation of that previously certified as shown by Defendant's "Exhibit No. 9". *Particular attention is requested to the conclusion made known and recorded in connection with Experiment 8, to wit, "The experiment indicates that by the ten minute dip in saturated boric acid solution, the abraded portion of the fruits will be protected from decay caused by spores falling upon them after the boric acid treatment."* Further particular attention is requested to the determination of effective strengths as found by Experiments 11 to 16, inclusive.

Jan. 20 Letter from H. C. Gore to G. Harold Powell reporting further on the progress of said work and enclosing a copy of the last mentioned report, Schedule 8.

Jan. 20 Letter from W. A. Taylor to G. Harold Powell acknowledging letters of the 9th, 11th and 13th inst. and telegram of the 14th inst; particular reference made to work on determining efficacy of various strengths of solution.

Feb. 6 *Letter from W. M. Scott to G. Harold Powell reporting that 3 per cent strength of boric acid used as a dip to prevent the development of the Penicillium rot in*

*oranges and lemons acts almost perfectly;* refers to prospective cooperation of Mr. Tenny in California and prospective test shipments.

*Date* *Nature of Record*

Feb. 15 Reply from G. Harold Powell to W. M. Scott promising additional observation tests in California and also commercial shipping tests "in a car going to Washington or to some near-by point". This letter expresses much interest in the Gore-Scott tests, as "suggestive of the value of the boric acid treatment for the purpose designed," but adds, "I am somewhat skeptical, however, in regard to the use of boric acid for this purpose, as I am afraid the trade would be very scary if it should get hold of the fact that any California fruits were dipped in this material. It would especially stir up our German friends."

Feb. 27 U. S. Department of Agriculture, Bureau of Plant Industry, Circular to the Citrus Fruit Industry, signed G. Harold Powell, Pomologist in Charge Fruit Storage Investigations.

This Circular stresses with much detailed discussion the prime importance of careful handling. For purpose of reference, there is attached to it here a letter from G. Harold Powell to W. A. Taylor, of January 13, 1905, setting out the beginnings of the careful handling investigation and some of the difficulties met with in practice.

Mar. 6. Report of field work of G. Harold Powell for week ending March 6, 1905. This re-

port shows results of boric acid tests with lemons and oranges, apparently examined at Prenda Packing House, Riverside, California, March 6, 1905.

Mar. 8 Letter from G. Harold Powell to W. M. Scott. Apparently this letter has not been found. It is indicated by a reference contained in W. M. Scott's reply, Schedule 16.

Mar. 20 Letter from W. M. Scott to G. Harold Powell acknowledging receipt of G. Harold Powell's letter of March 8, giving figures "quite favorable to the treatment". ("Test with boric acid on oranges and lemons.")

*Date* *Nature of Record*

Mar. 27 Letter from G. Harold Powell to W. M. Scott advising that press of work connected with orange shipments has prevented any shipments of lemons treated with boric acid, as anticipated in Scott's letter of March 20. But Powell adds, "I hope that we may be able to get at this within the next two or three weeks and make several shipments direct to Washington."

Apr. 12 *Letter from H. C. Gore to William A. Taylor purporting to enclose tables of experiments with boric acid and lemons, and discussing the results, in detail, as favorable;* also suggesting further experiments to test two points, whether previous soaking or rinsing after dipping hinders the action of boric acid on the fungus growths.

Apr. 20 Letter from H. C. Gore to William A. Taylor reporting on the points last mentioned, to-wit, that previous soaking in

water for ten minutes interfered with the action of the boric acid extended dip, "*but that rinsing has no such prejudicial effect upon the action of boric acid,*" under a preceding dipping in the boric acid solution. It is to be noted that the reports referred to as inclosed in this letter and the reports referred to as inclosed in the letter of April 12, Schedule 18, have not been found so far as we can learn.

1909

Oct. 26 Letter from G. Harold Powell to A. D. Shamel, Physiologist, Pasadena, California, referring to proposals concerning "the use of bicarbonate of soda for blue mould." "I will try to look up the notes and see what we did on this the first year we went to California. We did a good deal of work at Prenda and found no difficulty in killing the blue mould with strengths that did not injure the lemons. However, we did not follow this further, as I did not think it a good policy to encourage any method of retarding blue mould other than sound lemons. The work in California shows that the lemon, properly handled, does not decay from blue mould. We have therefore not thought it wise to develop any short-cut methods of retarding the rot, as this would shortly be followed by a letting-up in the careful handling methods * * * I wish you would think along this line somewhat from the standpoint of general policy in connection with the industry and see if you do not agree with me."

Nov. 8 Letter from G. Harold Powell to A. D. Shamel pursuing at much length the letter of October 26, Schedule 20. "I was interested in your remarks regarding the use of

sodium carbonate solution for blue mould. I do not think there would be very much trouble in finding some of these solutions, but as I wrote you before, I think it would be distinctly detrimental to the industry if a fungicide should be adopted even to cut out decay in the scarred and bruised lemons to which you refer. There would certainly be a let-up in the practices that are fundamental in keeping the product sound if the average grower could depend upon the fungicide to overcome a definite piece of careless work. Just as soon as the grower lets up in one fundamental, he always lets up in others. For that reason, I have always felt like holding rigidly in California to careful handling as the only means of retarding the common blue mould. By doing so, I am satisfied that it has had a splendid effect upon other operations in the lemon industry. There are some individuals who might be able to use fungicides and who would not let up, but they are few and far between."

In further compliance with your request, you are informed that these additional reports were not found at the time the certificate of January 18, 1927, was executed, but were discovered more or less by accident during a search for other old records in or about the month of February, 1930, and from time to time thereafter.

These additional records were not found in the first instance because the files containing them had been taken out of the regular or current files, and stored. They appear to have been moved from time to time, thereby rendering it difficult to find them. The failure to certify these records in the first instance was of course due in no way to a lack of diligence on the part of the American Fruit Growers, Inc.

Briefly, the records previously certified, together with these additional reports and correspondence, show that under a series of experiments conducted by the Department, the development of blue mold on citrus fruits was inhibited by dipping such fruits for a few minutes in a sufficient solution of boric acid and further that any surplus of boric acid crystals could be removed from the fruit by rinsing in fresh water without impairing the efficacy of the treatment.

A copy of this letter, together with a set of the certified copies enclosed, have this day been sent to Messrs. Mohun & Elliott, Attorneys at Law, Transportation Building, Washington, D. C.

Respectfully,

R. W. DUNLAP,
*Acting Secretary.*

The copies of the reports referred to are not here included because to do so would unduly extend this appendix. A complete set of the certified photostatic copies of such reports is being filed contemporaneously with the Clerk of this Court.

This official communication and these departmental records which constitute a part of such letter are proper subjects of judicial notice. See *United States v. Brewer-Elliott Oil and Gas Company*, 249 Fed. 609, affirmed 270 Fed. 100, and by this Court 260 U. S. 77. The trial court in that case said:

> The objections urged to these letters (from the Secretary of War), written after the trial of this case, and submitted on service of copies, are held not tenable as judicial notice should be taken of them (249 Fed. 619).

See also *American Banana Company v. United Fruit Company*, 160 Fed. 184, 187.

Copies of this motion, brief and appendix have been duly served upon counsel for petitioner and respondent.